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Part #25

REQUEST FOR CONTINUED EXAMINATION (RCE) TRANSMITTAL Subsection (b) of 35 U.S.C. §132, effective May 29, 2000, provides for continued examination of an utility or plant application filed on or after June 8, 1995. See The American Inventors Protection Act of 1999 (AIPA)	Application Number:	09/473,386
	Filing Date:	12/28/99
	First Named Inventor:	Mario Guillen
	Group Art Unit:	1661
	Examiner Name:	J. Hwu
	Attorney Docket No.	BAL5019P0090US

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Commissioner For Patents
Box RCE
Washington, D.C. 20231

This is a Request for Continued Examination (RCE) under 37 C.F.R. §1.114 of the above-identified application.

NOTE: 27 C.F.R. §1.114 is effective on May 29, 2000. If the above-identified application was filed prior to May 29, 2000, applicant may wish to consider filing a continued prosecution application (CPA) under 37 C.F.R. §1.53(d) instead of a RCE to be eligible for the patent term adjustment provisions of the AIPA. Changes to the Application Examination and Provisional Application Practice, Final Rule, 65 Fed. Reg. 50092 (Aug. 16, 2000); Interim Rule, 65 Fed. Reg. 14865 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office 47 (April 11, 2000), which established RCE practice.

1. **Submission required under 37 C.F.R. §1.114**

- a. ☐ Previously submitted:
- i. ☐ Consider the Amendment(s)/Reply under 37 C.F.R. §1.116 previously filed on _____.
 - ii. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____.
 - iii. ☐ Other: _____.
- b. ☒ Enclosed:
- i. ☒ Amendment/Reply
 - ii. ☐ Affidavit(s)/Declaration(s)
 - iii. ☒ Information Disclosure Statement
 - iv. ☐ Other: _____.

3. **Fees**

- a. ☐ The Director is hereby authorized to charge the following fees, or credit any overpayment, to Deposit Account No. 23-0785.
- i. ☐ RCE filing fee
 - ☐ Extension of time fee
 - ☐ Other _____.

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b. ☒ A check in the amount of \$740.00 is enclosed

☒ The Commissioner is authorized to charge payment of the following amounts associated with this communication or credit any overpayment to Deposit Account No. 23-0785:

☒ Additional filing fees under 37 CFR 1.16 or deficiencies in remittances therefor.

☒ Additional processing fees under 37 CFR 1.17 or deficiencies in remittances therefor.

4. **Correspondence Address:**

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Date: Dec. 16, 2002

Attorney's Signature

Lisa V. Mueller, Reg. No. 38,978

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this Request For Continued Examination Transmittal and any other documents referred to as enclosed herein, are being deposited in an envelope with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated below and addressed to: Commissioner for Patents, Box RCE, Washington, D.C. 20231.

Express Mail Label No.: EV214725036US

Date of Deposit: December 16, 2002

Typed/Printed Name of Person Signing: Kim Annel

Signature:



#25
12/31/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mario Guillen)

Serial No.: 09/473,386)

Filed: December 28, 1999)

Title: Trailing Interspecific Impatiens))

Group Art Unit: 1661

Examiner: J. Hwu

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Commissioner for Patents
Washington, D.C., 20231

RESPONSE

Sir:

This Response is being submitted in connection with the Office Action dated September 24, 2002 in the above-identified application.

REMARKS

Reconsideration of the above-identified application in view of the foregoing amendments and following arguments is respectfully requested.

Claim Rejections – 35 U.S.C. Section 112

Claims 13-24 and 26-30 are rejected under 35 U.S.C. Section 112, first paragraph as not being described in the specification in such a way to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant respectfully traverse this rejection.

The inquiry into whether the written description requirement is met is determined on a case-by-case basis and is a question of fact. *Manual of Patent Examining Procedure* Section 2163.04 (Eighth Edition, August 2001). A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. *Id.* The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. *Id.* The Examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Id.*

Claim 13 is directed to an interspecific impatiens plant that comprises a trailing habit and is produced by crossing an *Impatiens flaccida* plant with an *Impatiens Hawkeri* plant. Claim 14 relates to pollen of the above-described plant. Claim 15 relates to an ovule of said plant. Claim 16 relates to a tissue culture of regenerable cells from said plant. Claim 17 relates to asexually reproduced progeny of said plant. Claim 18 states that the asexually reproduced progeny of claim 17 is a cutting.

Claim 26 relates to a trailing interspecific *impatiens* plant produced by the process described in allowed claim 25. Claim 27 relates to pollen from a trailing interspecific *impatiens* plant produced by the process of claim 25. Claim 28 relates to an ovule from a trailing interspecific *impatiens* plant produced by the process of claim 25. Claim 29 relates to asexually reproduced progeny produced by the trailing interspecific *impatiens* plant produced by the process of claim 25. Claim 30 states that the asexually reproduced progeny of claim 29 is a cutting.

The specification on pages 1 and 3-6 describes novel *impatiens* plants having a trailing habit produced as a result of a unique interspecific cross between *Impatiens flaccida* and *Impatiens Hawkeri*. The specification provides examples of two *impatiens* plants, 2245B and 2257B, that were produced from this cross and have a trailing habit.

During the breeding process, ornamental plant breeders make various crosses and selections based on certain ornamental traits of interest, including, but not limited to flower color, flower size, plant habit, etc. Many trailing (also known as "spreading") *impatiens* plants are known in the art (see Plant Patents 4,720 and 5,698). Therefore, *impatiens* plant breeders are well versed in the types of habits that can be selected for a plant, including, but not limited to, a recumbent habit, an upright habit¹, semi-trailing habit, trailing habit, etc.

Therefore, using the information provided in the specification regarding this method, one of ordinary skill in the art could readily identify *impatiens* plants other than 2245B and 2257B having a trailing habit that are produced as a result of the unique interspecific cross between *Impatiens flaccida* and *Impatiens Hawkeri*.

Applicant respectfully submits that the Examiner has not provided a reasonable basis for challenging the adequacy of the written description of the present application. Specifically, the Examiner has not provided any evidence as to why one of ordinary skill in the art would not recognize that the present disclosure a description of the invention as defined in the claims. Therefore, in view of the aforementioned arguments, Applicant submits that this rejection should be withdrawn.

Enablement – 35 U.S.C. Section 112, First Paragraph

Claims 19-24 are rejected under 35 U.S.C. Section 112, first paragraph as not being enabled by the specification. Specifically, the Examiner states that regenerable tissues of seed of 2245B need to be deposited with a recognized depository pursuant to the Budapest Treaty.

Applicants wish to hold making such a deposit in abeyance until receipt from the Examiner of notification of allowable subject matter.

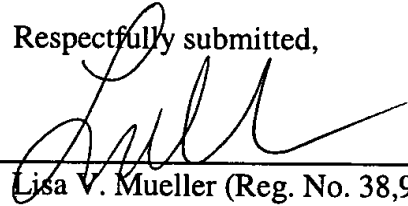
¹ See Toru Arisumi, "Cytology and Morphology of Ovule Culture-derived Interspecific *Impatiens* Hybrids," *J. Amer. Soc. Hort. Sci.*, 112(6):1026-1031 (1987), page 1028. Arisumi describes *impatiens* plants having "recumbent" and "upright" habits.

In view of the aforementioned amendments and arguments, Applicant submits that claims 13-24 and 26-30 are now in condition for allowance.

If any additional fees are incurred as a result of the filing of this paper, authorization is given to charge deposit account number 23-0785.

Respectfully submitted,

By: _____


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CERTIFICATE OF EXPRESS MAILING

I hereby certify that this Amendment is being deposited with the United States Postal Service with sufficient postage as Express Mail in an envelope addressed to: Commissioner for Patents, Box RCE, Washington D.C., 20231 on a December 11, 2002.

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